



Attorney's Docket No. 032326-022

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Patent
TC 2800 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Rene-Paul BLANC et al.

Application No.: 09/533,825

Filed: March 24, 2000

For: DISPOSABLE ELECTRONIC CHIP
DEVICE AND PROCESS OF
MANUFACTURE

Group Art Unit: 2841

Examiner: H. Bui

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated April 10, 2001, Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

The Office Action required restriction between claims 1-30, drawn to an electronic chip device, and claims 31-47, drawn to a process to manufacture an electronic chip device.

MPEP § 803 sets forth two criteria for a proper restriction requirement;

- a) the invention must be independent or distinct as claimed; and
- b) there must be a serious burden on the Examiner if restriction is required.

In the present case, the Examiner has classified the claims as a process of making and a product made by the process. In this situation, according to MPEP § 806.5(f), distinctness can be shown if the product as claimed can be made by another and materially different process. In support of the restriction, therefore, the Office Action states that the electronic chip device of claims 1-30 can be made by a screening process.

However, there is no showing that a screening process is materially different from the process recited in a number of claims of the second group. For instance, each of claims 31 and 32 recite the step of providing an interface support film including a support film and at least one flat interface. There is nothing in these claims which precludes the interface from being formed by a screening process. In fact, at page 18, lines 4-7, the application discloses that the interface support film can be obtained by a variety of known processes, such as engraving, *screen printing with conductive ink*, selective application of conductive material, etc. Hence, the application specifically encompasses a screening process as one of the implementations of the claimed method. There is no limitation in claims 31 or 32, or a number of their dependent claims, which precludes a screening process in the implementation of the method.


Accordingly, it is respectfully submitted that the Office Action has not set forth a showing of independent and distinct inventions that is necessary to meet the first criteria for a proper restriction requirement.

Furthermore, the Office Action does not address the second criteria for a restriction requirement, namely a serious burden on the Examiner. In the present situation, a thorough examination of the method claims would require a review of prior art relevant to apparatus claims 1-30. Similarly, a complete search conducted to the apparatus claims should involve a review of prior art relevant to method claims 31-47. Hence, it is respectfully submitted that the additional burden on the Examiner, if any, to consider all of the claims in a single application is minimal.

Accordingly, Applicants respectfully submit that the bases for a proper restriction requirement have not been set forth in the Office Action, and therefore it should be withdrawn. In an order that this response be complete, however, Applicants provisionally elect the subject matter of Group I, which encompasses claims 1-30, for purposes of further prosecution.

Respectfully submitted,

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